

REMARKS

Reconsideration and allowance of the present application based on the foregoing amendments and the following remarks are respectfully requested.

Claims 3-4 and 6-39 are currently pending in the present application. Of these claims, claims 16-39 are newly added.

Allowable Claims

The Applicants appreciate the indication of allowable claims. Although the Examiner indicated that claims 6-10 and 12-14 were allowable, it appears that he meant that claims 7-10 and 12-14 were allowable, as claim 6 is specifically discussed in the rejections. As such, the Applicants have re-presented these claims as new claims to secure their allowance as follows:

Original Claim(s)	New Claim(s)
7 (dependent from 6, 5, and 1)	16 (independent)
8, 9, and 10 (dependent from 7)	17, 18, and 19 (dependent from 16)
12 (dependent from 11, 3, 2, and 1)	20 (independent)
13 (dependent from 9)	21 (dependent from 18)
14 (dependent from 13)	22 (dependent from 21)

Prior Art Rejection

Independent claim 1 stands rejected as being obvious over admitted prior art (“APA”) in view of Chu. The Applicants have amended claim 1 to more clearly differentiate from the art applied by the Examiner.

Claim 1 has been amended to specifically recite the novel switch lock in the specific context of a shredder. Specifically, the shredder has been defined as including “a housing,” in which the “shredder mechanism” is mounted, and “a throat opening provided on the housing for enabling articles to be fed into the shredder mechanism.” Also, the “on/off switch” and the “manually engageable portion” of the “switch lock” are both “provided on an exterior of the housing.”

These limitations more specifically define the context of the invention as being directed to a shredder. Further, the location of the “switch lock” is more specifically defined as being on the exterior of housing of the shredder.

The applied prior art does not teach or suggest the use of a switch lock for locking or releasing the on/off switch of a shredder. Indeed, the Examiner does not cite to a single piece of prior art suggesting a need for or the desirability of using a switch lock on a shredder as recited in claim 1. This is insufficient to establish a motivation or suggestion to combine the applied prior art. *See e.g., In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). Indeed, the Federal Circuit has clearly stated that the Examiner is required to cite evidence to support his assertion underlying a *prima facie* case of obviousness. *See id.* at 1371. This applies to all elements of the *prima facie* case of obviousness, including establishing a motivation or suggestion to combine.

Moreover, the power tool disclosed in Chu is non-analogous and the use of a “switch lock” in that device is driven by different concerns that are not relevant to shredders. The tool illustrated in Chu has a trigger 300 and the “switch lock” is used to prevent inadvertent actuation of the trigger. With the power tool of Chu, the trigger is located on the handle by which the user grasps the tool. Thus, the mere grasping of the tool by the handle, as intended, may result in inadvertent actuation of the tool – an obvious safety problem. The provision of a switch lock in this context alleviates this problem by only allowing actuation of the trigger after first disengaging the switch lock.

However, a shredder does not share the same concerns as this type of power tool. Shredders are not manually grasped by any handle that would incorporate a trigger. Thus, shredders cannot be said to have the same concerns being addressed by the “switch lock” provided on the power tool of Chu.

Absent objective evidence to combine the applied art, the Examiner cannot rely on the asserted combination to maintain his obviousness rejection. At best, the Examiner has arguably identified prior art that is merely capable of being combined together – but that is not sufficient to support the *prima facie* case of obviousness. *See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *see also*, MPEP § 2143.01. More specifically, the Examiner has not cited any rationale why one of ordinary skill in the shredder art would be motivated to provide a “switch lock” on a shredder. This motivation cannot be derived from Chu, which addresses different concerns with a power tool having a handle-mounted trigger. And there is no teaching in the shredder art of the desirability or need for a “switch lock” on a shredder, absent the hindsight benefit of having read the Applicants’ disclosure.

Accordingly, claim 1 is submitted to be patentable over the art of record. The Examiner is therefore requested to withdraw the outstanding rejection to claim 1.

Claims 3-4, 6-15 and 23-30 depend from claim 1. These dependent claims are submitted to be patentable both for the reasons advanced with respect to claim 1, and for the reason that they recite separately patentable features.

For example, with respect to claim 3, Chu clearly does not teach a switch lock that is “constructed such that, when the on/off switch is in the on position thereof, moving the switch lock from the releasing position to the locking position causes the switch to move into the off position.” Reference may be made to the discussion set forth below for independent claim 31 for a more detailed discussion of this feature.

Claim 4 requires a “camming surface” and associated limitations that are clearly not taught or suggested by Chu.

Claim 15 recites a “visual indicator.” The Examiner has not cited a single reference teaching the limitations of claim 15, and instead has relied on mere conclusion. Thus, a *prima facie* rejection has not been made for claim 15.

New dependent claims 23-30 recite specific features about the location, construction, and interrelation between the “switch lock,” “the on/off switch,” and the “housing.” These specific features are not shown in the claimed context, and these claims are also submitted to be patentable.

#### New Claims 31-39

Claims 31-39 have been newly added to protect additional patentable features.

Independent claim 31 recites the advantageous feature of the “switch lock” being “constructed such that, when the on/off switch is in the on position thereof, moving the switch lock from the releasing position to the locking position causes the switch to move into the off position.” This feature is not taught by either the APA or Chu. Chu is relied on for the teaching of a “switch lock,” albeit in a non-analogous context, but it does not teach or suggest this feature recited in claim 31.

To the contrary, Figure 5 of Chu shows the condition where the “on/off switch” (*i.e.*, the trigger) is in the on position and the “switch lock” is in the releasing position. In this position, element 440 of the alleged “switch lock” is abutted against element 334 of the alleged “on/off switch” (*i.e.*, the trigger). The configuration of these parts is such that the “switch lock” cannot be moved to its “locking position” (which would be the position of Figure 3) until the trigger is first moved to its off position. Thus, moving the “switch lock” to

its “releasing position” cannot cause movement of the “on/off switch” to its off position as required by claim 31. Indeed, such a function is not even necessary in device of Chu because the trigger (on/off switch) is biased by a spring to the off position. Thus, the trigger will move to the off position under the spring bias upon release - avoiding the need to have the switch lock cause its movement as recited in claim 31.

Accordingly, claim 31 is submitted to distinguish over the art of record, and an allowance for claim 31 is requested.

Claims 32-35 depend from claim 31 and recite additional patentable features. For example, claim 32 recites the camming surface that is clearly lacking from Chu. Claim 33 recites a reverse position that is lacking in Chu. Claim 34 recites a location and type of mounting for the switch lock that is not taught by Chu.

Independent claim 36 recites the provision of “a status indicator provided on the exterior of the housing for visually indicating whether the switch lock is in the locking position.” The Examiner has not cited a single reference teaching or suggesting this feature. Although the Examiner stated that such a feature is “well-known,” no evidence in support of that statement has been provided. Accordingly, claim 36 is submitted to be patentable, and the Examiner is requested to allow it.

Claims 37 and 38 depend from claim 36 and recite additional patentable features.

Independent claim 39 recites and defines the switch lock as “including a locking portion connected to the manually engageable portion of the switch lock.” This locking portion includes “a recess configured to receive a portion of the on/off switch in the locking portion of the switch lock to lock the on/off switch in the off position.” The use of recess as claimed is not taught in Chu. Thus, the Examiner is requested to allow claim 39.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance, and a Notice to that effect is requested.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



BRYAN P. COLLINS  
Reg. No. 43560  
Tel. No. 703.770.7538  
Fax No. 703.770.7901

BPC/smm  
P.O. Box 10500  
McLean, VA 22102  
(703) 770-7900